

REMARKS

The Examiner is thanked for the thorough examination of this application. The Office Action, however, has rejected all claims 1-20.

Response to Rejections Under 35 U.S.C. §102

Independent claim 1 is amended to include all the limitations of claim 5 (and intervening claim 4), wherein three of the basic cell structures are arranged in a second equilateral triangle, and the fourth light emitting diode is disposed in the center of the second equilateral triangle. The Office Action originally rejected claim 5 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent 6,856,087 to Lin. However, Lin's does not disclose a fourth light emitting diode disposed in the center of the second equilateral triangle, as specifically claimed in original claim 5 (now claim 1). The Office Action (see p. 3, first paragraph) cited FIG. 5H of Lin as teaching this feature. However, this Figure of Lin shows three LED elements disposed in the configuration of an equilateral triangle. However, as specifically defined in claim 4, a fourth LED disposed in the center of a second equilateral triangle. Simply stated, no such configuration is disclosed or suggested by Lin. For at least this reason, the rejection of independent claim 1 should be withdrawn.

Similarly, claim 11 is amended to include all the limitations of claims 14 and 15. Like claim 1, independent claim 11 defines a fourth LED disposed in the center of a second equilateral triangle. Thus, for the same reason as claim 1, claim 11 defines over the teaching of Lin and should be allowed.

All other claims depend from either claim 1 or 11, and define over the cited art for at least the same reasons.

Response to Rejections Under 35 U.S.C. §103

The Office Action rejected claims 3, 7, 8, 13, 17, and 18 under 35 U.S.C. § 103(a) as allegedly unpatentable over the combination of Lin with U.S. published application 2004/0196374 to Billerbeck. Applicants respectfully disagree, for at least the reason that each of these claims depend from an allowable claim. Further, the limitations that are now present in the base claims make these claims narrower than previously. Therefore, the previous rejections are rendered moot by the amendments to claims 1 and 11.

As a separate and independent basis for the patentability of these claims, Applicants respectfully submits that the Office Action has failed to cite a proper motivation or suggestion for combining the cited references. For example, in combining *Lin* and *Billerbeck*, the Office Action stated only that the combination would have been obvious "in order to obtain good resolution and color balance." Office Action, p. 4. This alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged

with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive a backlight module, as claimed by the Applicants.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 ("The absence of such a suggestion to combine is dispositive in an obviousness determination.").

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

Merely identifying some benefit (from hindsight) that results from a combination is not sufficient to justify the combination, and the motivation or suggestion must come from the prior art itself, and the Office Action has failed to identify such proper motivations. As noted above, the Office Action stated that the motivation would be "to obtain good resolution and color balance." The undersigned respectfully submits that a variety of structures can result in good resolution and color balance. Thus, something more (in the form of a motivation) is required in order to combine the specific features from Billerbeck and Lin, which are relied upon by the Office Action. For at least this additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, the rejection of claims 3, 7, 8, 13, 17, and 18 should be withdrawn.

With regard to claims 10 and 20, the Office Action combined U.S. patent 4,125,319 (to Frank) with Lin. The Office Action alleged that this combination would have been obvious "in order to control the light rays incident on an operative area." For legal reasons, similar to those

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advance above in connection with claim 3, Applicants respectfully submit that the rejections of claims 10 and 20 should be withdrawn.

CONCLUSION

For at least the reasons described above, independent claims 1 and 11 are allowable over the cited references. Insofar as the independent claims define over the cited art, the remaining (dependent) claims patently define over the cited art as well.

Should Examiner feel that further discussion of the application and the Amendment is conducive to prosecution and allowance thereof, please do not hesitate to contact the undersigned at the address and telephone listed below.

No fee is believed to be due in connection with this Amendment and Response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

By:



Daniel R. McClure, Reg. No. 38,962

Thomas, Kayden, Horstemeyer & Risley, LLP
100 Galleria Pkwy, NW
Suite 1750
Atlanta, GA 30339
770-933-9500